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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,330	12/17/2003	Michael Anthony Zerillo		7560

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EXAMINER

HAWK, NOAH CHANDLER

ART UNIT PAPER NUMBER

3637

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/737,330

Applicant(s)

ZERILLO, MICHAEL ANTHONY

Examiner

Noah C. Hawk

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

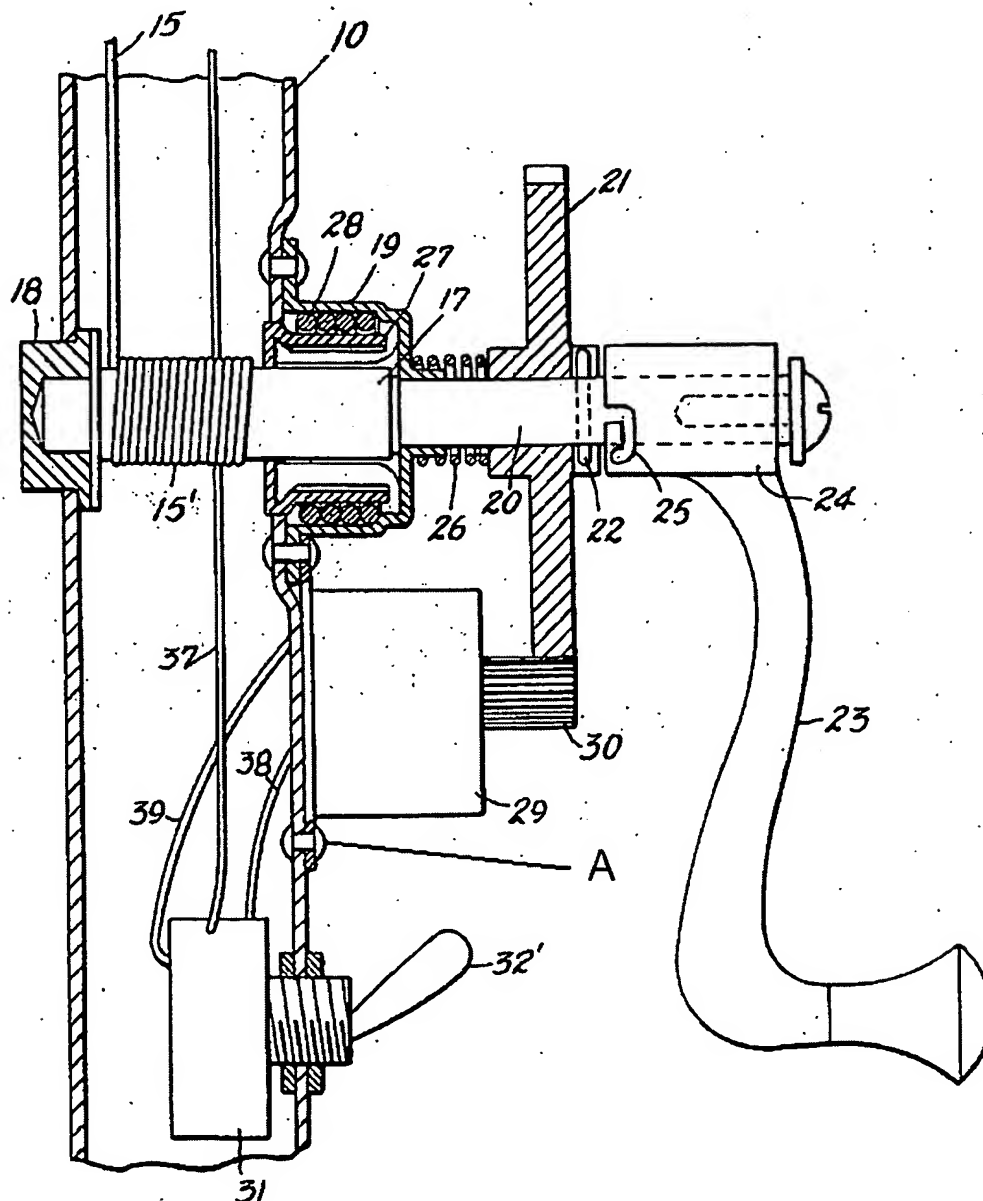
a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in US Patent 6182917 in view of Small in US Patent 2960094. Lai discloses a "retrofit" electric opening and closing device for new and existing umbrellas, the device comprising a reversible electric motor (21), a reel drivingly engaged with the motor (24) a housing means for the motor and the reel (12), a length of cable (33) affixable at one end to the reel, a means to provide electricity (See Lai, Column 2, lines 14-15), a switch (10) having two means (See Lai, Column 4, lines 12-15) to connect or disconnect the electricity to the motor, a remote control receiver (11) having two means (See Lai, Column 4, lines 12-15) to connect or disconnect the electricity to the motor, and a remote control transmitter (See Lai, Column 1, lines 26-28) having means to control the remote control receiver. Lai is silent on which direction the motor turns it relates to the controlling element of the switch or remote receiver. However, it would be obvious for the engagement of a first means in a controlling element such as a switch or a remote receiver to connect electricity to the motor and cause the motor to turn in a first direction of rotation thereby causing the umbrella to open, and for disengagement of the first

means of a switch or remote control receiver to disconnect electricity from the motor and cause it to stop rotating in a first direction thereby causing the umbrella to stop opening. Further, it would be obvious for the engagement of a second means in a controlling element such as a switch or a remote receiver to connect electricity to the motor and cause the motor to turn in a second direction of rotation thereby causing the umbrella to close, and for disengagement of the second means of a switch or remote control receiver to disconnect electricity from the motor and cause it to stop rotating in a second direction thereby causing the umbrella to stop closing. Lai does not disclose that the opposite end of the cable is affixable to the patio umbrella opening and closing means, nor does he disclose a means to affix the housing to the patio umbrella at a location to thereby establish control of the patio umbrella opening and closing means. Small discloses a motor device for an umbrella, the device having a cable (15) affixed at one end to a reel (17), the opposite end of the cable being affixable (See Small, Column 1, lines 50-54) to the patio umbrella opening and closing means (13). Small also discloses a means (A) to affix the housing to the patio umbrella at a location to thereby establish control of the patio umbrella opening and closing means. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Lai by using a cable attached at an opposite end to the patio umbrella opening and closing means and to use a means to attach the housing a location to thereby establish control of the patio umbrella opening and closing means as taught by Small in order to ensure that the motor is in control of the operation of the umbrella and that it is firmly attached at a convenient position to the umbrella. Please note that it has been held that

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the functional “whereby” statement does not define any structure and accordingly can not serve to distinguish. Therefore, the limitation “whereby a person with ordinary skill can attach the device to the opening and closing means of the patio umbrellas with little or no modification” has been given no patentable weight. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).



Small, Figure 2

Response to Arguments

3. Applicant's arguments filed September 23, 2005 have been fully considered but they are not persuasive.

4. In response to applicant's argument that the device is intended for use as a retrofit device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Although the applicant repeatedly refers to the device as "retrofit" and "designed for do-it-yourself installation," there is no structure in the claims to distinguish it from the prior art of Lai and Small cited by the examiner.

5. In response to the applicant's argument that the prior art is not drivingly engaged with the opening and closing means, the difference between the claimed device and the prior art of Lai and Small is not compelling. The applicant discloses a motor engaged through a series of gears to drive a pulley, thereby winding or unwinding a cable attached to the opening and closing means of the umbrella. The prior art of Small discloses a motor engaged through a series of gears to drive a pulley, thereby winding or unwinding a cable routed around another pulley and attached to the opening and closing means of the umbrella. The difference between the two methods of driving engagement is minimal at best and is not sufficient to warrant patentability.

6. In response to the applicant's reference to the devices of Ma, Moga and Kuelbs, the applicant's argument is moot since these references are not used against the claims or applied in the rejection.

7. In response to the applicant's reference to the device of Vivian et al., the Office understands that the Vivian et al. application was filed after the one under review. However, as stated above, it was included for the sake of thoroughness as it was deemed significant. If a rejection had been made based on this reference, its mention would be warranted in the applicant's response. However, as stated above, no argument need be made on this reference because it was not specifically used in an art rejection.

8. In response to the applicant's Narrative Summary, the applicant has not established a prime-facie case of non-obviousness to define the claimed invention over the prior art.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Russell, Wu and Small in US Patent 2951492 disclose umbrella opening and closing devices with cables attached to the umbrella opening and closing means. Wilson, Vivian et al., Kuelbs in Application 2004/0149325 and US Patent 6612713, Moga, Grady II and Ma disclose motorized umbrella devices.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah C. Hawk whose telephone number is 571-272-1480. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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10/12/05

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